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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/800,144      | 03/12/2004  | Jerry W. Browning    | ORAL.001A           | 6799             |

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| EXAMINER |
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MANAHAN, TODD E

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3732

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/800,144 | Applicant(s)<br>BROWNING ET AL. |  |
|                              | Examiner<br>Todd E. Manahan   | Art Unit<br>3732                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it contains "said". Legal terminology such as "said" and "means" should be avoided. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 16, 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 14 and 44, the functional recitation that "the focus of the light is adjustable" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

In claims 16 and 45, the functional recitation that "the opening for delivering water is adjustable" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-6, 8-15 and 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. (United States Patent No. 5,308,242) in view of Reeves et al. (United States Patent No. 5,538,425).

McLaughlin et al disclose a disposable dental instrument driven by compressed air comprising: an elongated body, said elongated body comprising: a first shell, a second mating shell, and a core, said first and second shells joined to form an exterior surface for manual manipulation, said shells forming a cavity, said cavity comprising a first set of integrally formed grooves within a cavity wall, said core comprising a second set of integrally formed grooves matching up with said first set of grooves, said first and second set of grooves being matched in shape and location to define various passageways as fluid conduits; a base, said base comprising: a plurality of conduits, said base communicating with an outside source of light, air, and water through said conduits, said conduits communicating with said passageways defined by said elongated body; a head located at the opposite end from said base, said head comprising: a supporting shaft, bearings rotatably supporting an upper and lower end of said supporting shaft, a turbine impeller, said turbine impeller connected to said supporting shaft, said turbine impeller being driven by said compressed source air through an air nozzle to rotate a dental bur a dental bur mounting system, a dental bur removal system, said dental bur removal system having an access hole to allow an object to push out said dental bur from said supporting shaft; and various openings located proximate to said head, said various openings delivering light, air, and water in the general direction of said dental bur (see claims 1 and 2). McLaughlin et al. does not show each bearing positioned within a bushing. Reeves et al. disclose a disposable dental tool having a turbine wherein the bearings are mounted in bushings in the head (see col. 7, lines 49-65). To

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mount the bearings of the device of McLaughlin et al. in bushings in view of Reeves et al. would have been obvious to one skilled in the art in order to provide a better bearing surface such that pressure applied to the burr does not effect the speed of the drill. Regarding claims 10 and 11, to make the turbine blades curved or of a paddlewheel configuration would have been an obvious matter of design choice to one skilled in the art. Regarding claims 18-32, the type and material from which the bearing surfaces are formed would have been obvious to one skilled in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 2-6, 8-15 and 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Bailey (United States Patent No. 6,186,784).

McLaughlin et al disclose the claimed invention except that turbine shaft is supported by bearings instead of bushings. Bailey shows that bushings are an equivalent structure known in the art (see col. 9, lines 26-33). Therefore, because these two friction reduction devices were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute bushings for bearings. Regarding claims 10 and 11, to make the turbine blades curved or of a paddlewheel configuration would have been an obvious matter of design choice to one skilled in the art. Regarding claims 18-32, the type and material from which the bearing surfaces are formed would have been obvious to one skilled in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Bailey as applied to claim 2 above, and further in view of Cardarelli (United States Patent No. 6,305,935).

Cardarelli discloses coating the exterior surface of a dental tool with rubber (see col. 5, line 29-33). To coat the exterior of the tool of the combination McLaughlin et al. and Bailey with rubber in view of Cardarelli would have been obvious to one skilled in the art in order to provide an enhanced gripping surface.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Bailey as applied to claim 2 above, and further in view of Franetzki et al. (United States Patent No. 5,352,118).

Franetzki et al. discloses a dental tool having a water outlet wherein the water outlet is adjustable. It would have been obvious to one skilled in the art to make water outlet of the tool of the combination McLaughlin et al. and Bailey adjustable in view of Franetzki et al. in order to permit the flow of water onto the target site to be varied.

Claims 34-38, 40-44, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Dutt et al. (United States Patent No. 5,263,606).

McLaughlin et al. disclose everything except for a shell half joining system incorporating said first shell half and said second shell half, said first shell half incorporating a square angled protruding surface along the entire joining edge of said first shell half, said second shell half incorporating a triangular shaped recess surface along the entire joining edge of said second shell half, said square angled protruding surface desired to integrally join with said triangular shaped recess surface to form a strong, water and air proof connection. Dutt et al. disclose forming a

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fluid tight connection using a square angled protruding surface 23 along the entire joining edge of a first part and a triangular shaped recess surface 33 along the entire joining edge of a second part. It would have been obvious to one skilled in the art to provide the first shell half with a square protrusion and the second shell half with a mating triangular recess in view of Dutt et al. in order to provide a strong fluid tight joint upon plastic welding thereof. Regarding claim 42, to make the turbine blades curved would have been an obvious matter of design choice to one skilled in the art.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Dutt et al. as applied to claim 34 above, and further in view of Cardarelli.

Cardarelli discloses coating the exterior surface of a dental tool with rubber (see col. 5, line 29-33). To coat the exterior of the tool of the combination McLaughlin et al. and Dutt et al. with rubber in view of Cardarelli would have been obvious to one skilled in the art in order to provide an enhanced gripping surface.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Dutt et al. as applied to claim 34 above, and further in view of Franetzki et al.

Franetzki et al. discloses a dental tool having a water outlet wherein the water outlet is adjustable. It would have been obvious to one skilled in the art to make water outlet of the tool of the combination McLaughlin et al. and Bailey adjustable in view of Franetzki et al. in order to permit the flow of water onto the target site to be varied.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713.

The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T.E. Manahan  
2 February 2005

Todd E. Manahan  
Primary Examiner  
Art Unit 3732

